



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,282	04/10/2006	Robert Peter Millar	638772009900	6069
25226 7590 04/06/2009 MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018				
EXAMINER BASKAR, PADMAVATHI				
ART UNIT 1645		PAPER NUMBER		
MAIL DATE 04/06/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,282

Applicant(s)

MILLAR, ROBERT PETER

Examiner

Padma V. Baskar

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 and 28-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1645

RESTRICTION

1. Applicants amendment filed on 5/9/05 has been entered.
Claims 23-27 have been canceled.
Claims 3-4, 6, 11-17, 19-22 and 28-29 have been amended. However, the amended claim 29 depends on a canceled claim 28. The examiner understands that it is an oversight made by the applicant and interpreting the claim 29 depends on claim 28 for examination. Applicant is advised to make a note of it and amend the claim 29.
1-22 and 28-29 are pending in the application.
2. Restriction is required under 35 U.S.C. 121 and 372.
This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-16 and 28-29 drawn to a peptide and vaccine comprising said peptide .
Group II, claims 17-19 drawn to a method of treating a disease, prostate cancer Or breast cancer Or ovarian cancer Or uterine cancer Or endometriosis Or uterine fibroids Or precocious puberty.
Group III , claim 20 drawn to a method of controlling fertility .
Group IV, claim 21 drawn to a method of controlling the heat cycle or method of contraception.
Group V , claim 22 drawn to a method of contraception.
3. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special feature technical features for the following reasons:

The technical feature of linking groups appears to be that they are all related to peptides. However, Mathias US-PAT-NO: 5,434,136 disclose GNRH peptide as shown below that is substituted with one or more D-amino acids (see SEQ.ID.NO:1 and summary of the invention, 1st paragraph), said more D-amino acids can be all are D-amino acids.

07-965-675-1 with claimed peptide GPRLGYSWIX, where X is E.

Query Match 100.0%; Score 63; DB 1; Length 10;
Best Local Similarity 100.0%; Pred. No. 0.00028;
Matches 10; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Art Unit: 1645

Qy	1	GPRLGYSWHE 10
Db	1	GPRLGYSWHE 10

Or

Mathias US-PAT-NO: 5,434,136 in view of HERVÉ (M. Hervé et al. Mol. Immunol. (1997) 34(2), pages 157-163). Mathias teaches the peptide GNRH as described above. It is noted that the instantly claimed peptide is the retro-inverso form of GPRLGYSWHE. Hervé teaches that retro-inverso peptides retain the side chain orientation and that "since several retro-inverso peptides have retained full biological activity, such a modification appears as an attractive approach to tentatively control the proteolytic sensitivity of biologically active peptides and hence to prolong their *in vivo* lifetime (see page 160). It would have been obvious to have synthesized and used the retro-inverso GPRLGYSWHE to obtain the benefits of retained full biological activity and prolong the *in vivo* lifetime. One would have been motivated to have done so, as Mathias teaches that modifications, including substitutions of one or more D-amino acids is contemplated as increasing the stability for oral administration. One would have had a reasonable expectation of success for using peptide disclosed by Mathias and converting into retro-inverso peptide for retaining the biological activity of peptide as taught by Hervé, while having the advantages of reduced proteolysis and increased *in vivo* lifetimes. Therefore, the technical feature of linking groups I-V does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art and hence unity of invention is lacking.

Accordingly, Groups I-V are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept under Rule 13.1.

5. Applicant is required, in reply to this action, to elect a group to which the claims shall be restricted. The reply must also identify the claims readable on the elected invention, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

6. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Right Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m. except First Friday of each bi-week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mondesi Robert can be reached on (571) 272-0956.

Respectfully,

/Padma v Baskar/

Examiner, Art Unit 1645

/Robert B Mondesi/

Supervisory Patent Examiner, Art Unit 1645